

REMARKS

Claims 1, 3-23, and 27-32 are present in this application. Claims 1, 15, and 19 are independent claims.

§ 101 Rejection

Claims 15-20, 22, 23, 28, 29, 31, and 32 have been rejected under 35 U.S.C. 101, as being directed to non-statutory subject matter. Applicants have amended the claims. Applicants request reconsideration of the rejection based on the claims as amended.

The Office Action alleges that a “computer-readable medium” can include a “carrier wave.” The Office Action alleges that a “system” can be a “computer-readable medium.”

Applicants amended the claimed “computer-readable medium” to instead recite “computer-readable memory medium” to avoid the assumption that the claimed medium can include a carrier wave. With respect to the claimed “system,” Applicants submit that a system that includes a processor would preclude a system being a carrier wave. In any case, Applicants have also amended claim 15 to include “input device.” Furthermore, Applicants submit that a system is an apparatus.

§ 103(a) Rejections

Claims 1-26 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Application Publication 2003/0215142 (Gounares). *It is noted that claims 2 and 24-26 have been canceled.* Claims 27-29 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gounares in view of U.S. Application Publication 2005/0041834 (Wakeam). Claims 30-32 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Gounares in view of U.S. Application Publication 2003/0053084 (Geidl).

Applicants have amended the claims based on an interview conducted with the Examiner on February 10, 2009. Applicants believe that the claim amendments address all issues discussed during the interview. Applicants invite the Examiner to contact the applicants’ representative in the event that such further discussion would place the application in condition for allowance.

During the interview, the Examiner had indicated that “determining” an original size can include inputting a size parameter value. The present specification discloses, for example, that “the average height (or other size characteristic) of the various ink characters may be determined (s806), and a corresponding font size for the machine generated text also will be determined (S808) based on the determined ink size characteristic.” (specification at para. 60; see also para. 44). In other words, the present specification uses the term “determine” for its action of calculating an average size, as well as, for another size characteristic. Thus, Applicants have amended the claims to recite “calculating,” for example a maximum height (specification at paragraph 60, which defines determining an average height; average height includes a step of determining the maximum height), as the type of “determining.”

During the interview, the Examiner expressed that the term “substantially equal” is relative. Applicants have amended the claims to instead recite an action that the size of machine-generated objects is set to an equivalent said calculated height. (the amended is based on the specification at paras. 60, 61, which indicates that a font size is for rendering the machine-generated text).

Gounares at paragraph 0029 discloses setting a size attribute of an ink object based on a size attribute at an insertion point (i.e., text around an insertion point). Applicants submit that paragraph 0029 of Gounares does not disclose calculating the size of the electronic ink. Each of the independent claims has been amended to clarify this feature.

For at least these reasons, Applicants submit that the claimed invention is patentable over Gounares. In addition, Applicants submit that Wakeam and Geidl fail to make up for the deficiencies in Gounares. Applicants request that the rejections be reconsidered and withdrawn.

CONCLUSION

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact **Robert Downs** Reg. No. 48,222 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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